

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-12 are presently active in this case, Claim 1 having been amended by way of the present Amendment. Claims 2 and 6-12 have been withdrawn from consideration as being directed to a non-elected species of the invention. The Applicant submits that amended Claim 1 remains generic to all of the species identified in the Election of Species dated December 14, 2004.

In the outstanding Official Action, the drawings were objected to under 37 CFR 1.83(a). The Official Action indicated that “a holding device configured to rotatably support the first rolled paper, said holding device being configured to enable movement of the first rolled paper from a first position to said holding device to a second position on said holding device” must be shown or canceled from the claims. The Applicant notes that Claim 1 has been amended to recite “a holding device configured to rotatably support the first rolled paper, said holding device having a slanted surface configured to support and guide movement of the first rolled paper from a first position on said holding device to a second position on said holding device,” which the Applicant submits is depicted in the figures of the present application. By way of illustration and not limitation, the application depicts an embodiment in Figure 9 that includes a holding device (5) that has a slant part (21) configured to support and guide movement of the rolled paper (2) from a first position (P1) to a second position (P2). The remaining figures disclose alternative embodiments of these

features. Since the Applicant submits that the features of the claims are depicted in the figures, the Applicant respectfully requests the withdrawal of the objection to the drawings.

Claims 1 and 3-5 were rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. As discussed above, Claim 1 has been amended to recite "a holding device configured to rotatably support the first rolled paper, said holding device having a slanted surface configured to support and guide movement of the first rolled paper from a first position on said holding device to a second position on said holding device," which the Applicant submits is enabled by the disclosure of the present application. By way of illustration and not limitation, the application discloses an embodiment depicted in Figure 9 and described in the corresponding section of the detailed description, which includes a holding device (5) that has a slant part (21) configured to support and guide movement of the rolled paper (2) from a first position (P1) to a second position (P2). The remaining figures and descriptions disclose alternative embodiments of the invention. Accordingly, the Applicant respectfully requests the withdrawal of the enablement rejection.

Claims 1 and 3 were rejected under 35 U.S.C. 102(b) as being anticipated by Fortuna et al. (U.S. Patent No. 5,906,333). Claims 4 and 5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fortuna et al. in view of Fuji (JP 5-337544). For the reasons discussed below, the Applicant respectfully requests the withdrawal of the art rejections.

In the Office Action, the Fortuna et al. reference is indicated as anticipating independent Claim 1. The Applicant notes that a claim is anticipated only if each and every

element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As will be demonstrated below, the Fortuna et al. reference clearly does not meet each and every limitation of amended independent Claim 1.

Claim 1 of the present application recites a rolled paper conveying apparatus comprising, among other features, a holding device configured to rotatably support a first rolled paper, where the holding device has a slanted surface configured to support and guide movement of the first rolled paper from a first position on the holding device to a second position on the holding device. The Applicant submits that the Fortuna et al. reference does not disclose such features.

The Fortuna et al. reference describes a frame 20 for the unwind stand which includes a pair of side frames as at 20a and 20b. The frame 20 pivotally supports arms generally designated as 21, which is essentially U-shaped. The arm on the operating side is designated 21a while the arm on the drive side is designated 21b. Interconnecting and rigidifying the two arms is a transverse member 21c. The arms are seen to support a parent roll R which, as can be quickly appreciated from a consideration of FIGS. 3 and 4, is in the process of being unwound to provide a web W. A thread-up conveyor is designated 24, a core placement table is designated 25, and a cart for supporting a parent roll R' subsequently to be unwound is designated 26.

The Official Action refers to feature 21 as the holding device of the present invention and Figures 8 and 9 as depicting the first and second positions, respectively. The Applicant submits that the arms 21 do not have a slanted surface configured to support and guide

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movement of the parent roll R' from the position in Figure 8 to the position in Figure 9. No such slanted surface is present on the arms 21 of the Fortuna et al. reference. In fact, the Fortuna et al. reference does not disclose any feature having the slanted surface as recited in Claim 1 of the present application.

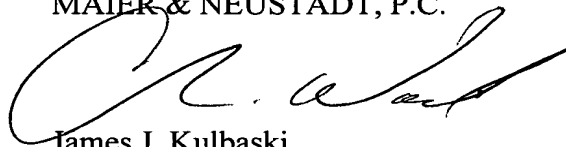
Accordingly, the Applicant respectfully requests the withdrawal of the anticipation rejection of Claim 1.

Claims 3-5 are considered allowable for the reasons advanced for Claim 1 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of Claim 1.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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